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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,934	01/22/2001	Carl A. Wright	SLC-10102/29	1234
25006 7590 03/15/2007 GIFFORD, KRASS, SPRINKLE, ANDERSON & CITKOWSKI, P.C PO BOX 7021 TROY, MI 48007-7021			EXAMINER GARG, YOGESH C	
			ART UNIT 3625	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE 3 MONTHS			MAIL DATE 03/15/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/766,934

Applicant(s)

WRIGHT, CARL A.

Examiner

Yogesh C. Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-29 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-29 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's Response to Non-Final office action received on 1/19/2007 is acknowledged and entered. None of the claims is currently amended. Claims 30 and 31 are withdrawn in the previous office action. Claims 24-29 and 32 are pending for examination.

Claim Objections

2. Claim 32 is objected to because of the following informalities: It recites in line 1, " The method of claim 1" which is incorrect and should be replaced by—The method of claim 24---. Appropriate correction is required.

Election/Restrictions

3. Applicant has not responded to Election/Restrictions requirement. Because applicant did not traverse the election/restriction requirement the election of claims 24-29 and 32 has been treated as an election without traverse and claims 30 and 31 are withdrawn.

Response to Arguments

4. In response to applicant's arguments that the support for claim 32 is in the originally filed claim 12 rejection of claim 32 under 35 U.S.C. 112, first paragraph is withdrawn.

Applicant's arguments filed 1/19/2007 concerning prior art rejection of claims 24 and 32 have been fully considered but they are not persuasive for the following reasons:

The applicant argues (see pages 1-2) that Ensel does not disclose software objects operative to either access an outside source, another object, or create a new object for

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acquiring and processing data for providing customized bills. Objects, as understood by examiners, are codes which can be directly executed by a system's central processing. Ensel discloses that his invention uses object oriented databases (see col.4, lines 36-38. The database files 205-230 which include data and files: Enrolment file 205 containing enrollment data, Summary file 210 containing customer's information, E-Bill file 215 containing both current and historical data related to E-bills, Template file 220 containing data related to format electronic bills, Payment file 225 containing data related to payments and Inquiry File 230 containing data related to customer and biller inquiries are all object oriented and data is stored as objects (see Fig.5 and col.10, line 3-col.11, line 5) allowing customized generation of bills according to the biller or industry specific. In this regard, the BPAI interpretation in the Board decision mailed on 5/16/2006 for the instant application, is also persuasive and relevant (see page 6) that in Ensel " the data used for bill contents are stored as objects in an object oriented file indicates that the objects are instantiated, i.e. created or generated, when invoked",..... Applications "plug-ins" residing on application server 240 accomplish the actual formatting of the electronic bills. The plug-ins contain the software required to format the data in E-Bill 215 and Summary 210 files for the channel of distribution to which an electronic bill is to be published. There is a different plug-in for each channel of distribution. We note that such plug-ins require an application programming interface that provides protocols that must be invoked by software that is structured as objects, whether by that name or another, further evidencing the generation of objects to collect data pertinent to the client and the bill format." Further, Ensel teaches that IIP acquires and accesses billing data from outside sources such as from the accounting system of the Biller and the data which is stored as objects can be instantiated, i.e. created or generated when invoked (see at least col.4, lines 17-38 and col.6, lines 32-50).

The applicant further argues (see page 2) that Ensel does not teach " repetitively invoking the software objectsuntil all the objects have completed the data acquisition and processing actions required to generate the customized bill format". The examiner disagrees because Ensel's system, that is IIP, in order to generate, format and present the bills to customers accesses and acquires all the billing data needed to publish and present the bills to customers and this will require repetitively invoking the different objects stored in different files 205-230, that is Enrollment file 205, Summary file 210, E-bill file 215, template file 220, payment file 225 and Inquiry file 230.

The applicant further argues (see pages 2-3) that in Ensel " Content is not generated " but it is received from the billers. The examiner does not agree because Ensel does generate the billing data after receiving the raw data from billers into the final presentation format as per the preference of the billers (see at least col.4, lines 17-38 and col.6, lines 32-50 and col.10, line 3-col.11, line 5).

With reference to claim 32, the applicant alleges that the examiner has used hindsight in combining the combined arts of Ensel and Lakritz to claim the applicant's invention. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, the examiner has used only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

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In view of the foregoing the rejection of claims 24-29 and 32 is sustainable as presented in the previous office action.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 24-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Ensel et al.

9US Patent 6,493,685 B1), hereinafter, referred to as Ensel.

Regarding claim 24, Ensel discloses a method of providing customized billing services, comprising the steps of:

providing a plurality of software objects, at least certain of which are capable of accessing an outside source, accessing one or more other software objects, or creating one or more new software objects, each object being operative to acquire and process data specific to a bill or the recipient thereof; configuring a subset of the software objects to generate customized bill content for a particular bill recipient; repetitively invoking the software objects of the subset, and any software objects that they access or create, until all of the objects have completed the data acquisition and processing actions required to generate the customized bill content; and producing a bill by formatting the customized bill content for the particular bill recipient See at least the following segments:

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col.6, lines 43-50, *"As described in more detail below, it is the responsibility of the IIP 20 to reformat the billing data 55 in the format required for its own internal databases and then to format the actual published bill, statement or other information as is appropriate for the channel of distribution particular to a specific customer 80 receiving the presented bill or other information."*

col.4, lines 17-39, *" In order to carry out the task of presenting the bills to the consumer, the IIP must have access to the "raw" billing data from the biller. This access can be accomplished either through direct access by the IIP to the accounting systems of the biller or through a data feed from the biller to the IIP. Once the billing data has been received by the IIP, the IIP formats the billing data for storage in its own internal database and then performs the task of formatting the bill for the particular channel(s) of distribution selected by the customer. Each biller has its own format and content for its "raw" billing data. Each channel of distribution has a distinct format and restrictions on content. Each customer has its own selected preference(s) for the channel on which the bill is to be presented. In light of all of these variables, the function of correctly formatting a particular bill for a particular customer is a significant task for the IIP. The present invention performs this formatting task using relational and object oriented databases which are the core of the BAP "*, and also Figs.2, 5, and

col.10, line 3-col.14, line 5 *"FIG. 2 illustrates an overview of structure of the elements of the present invention as well as the processing and data flow. Element 200 illustrates the structure of the Biller Acquisition Platform (BAP). The central feature of the design of the BAP 200 is that it is a database driven system. The BAP 200 includes a database server 202 having, for example, six database including an Enrollment file 205; a Bill Summary file 210; an E-Bill file 215 containing both current and historical data related to E-Bills; a Template file 200 containing the templates required to format electronic bills for the various channels of distribution 310-320; a preferred presentment vehicle (channel of distribution) and alternate presentment vehicles; customer presentment preferences (e.g., present my bill as soon as available, at the end of month,*

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exception presentment (only present my bill if dollar amount exceeds a limit, otherwise automatically pay the bill, generate a paper bill if condition X occurs . . .)); presentment configuration data (e.g., Email address, Email system/protocol, browser type and version . . .); bill format preferences (e.g., send me summary only, partial details, full details . . .); reminder preferences The structure and content of the Summary file 210 and the E-Bill file 215 varies from biller to biller. The Summary file includes the highest level representation of the customer's bill. Examples of the type of data included in the Summary file 210 are the customer's name, account number, location (address) of the bill destination, account balance, current amount due, amount past due, and minimum due. The E-Bill file 215 contains data related to the customer's current E-Bills along with historical E-Bill data which is retained for a certain period of time. The E-Bill data residing in this file 215 contains the detailed description of the customer's bill (e.g., details of all of the charges on a credit card for the applicable period in the case of a credit card biller). In a preferred embodiment of the present invention, the E-Bill file 215 is an object oriented file in which the E-Bills are stored as objects. The E-bill file 215 can be both industry specific and/or biller specific. For example, if the IIP 20 has several utility billers, a standard format for a utility bill can be derived (e.g., a graph illustrating the customer's usage). Within the standard format, each utility biller can customize the format of its own bill to be presented to its customers 80. Alternatively, each biller can custom format the entire look and feel of its bill.....",

col.12, lines 12-18 and lines 31-42, " if the biller 5 desires to maintain electronic data for all of its customers 80, in anticipation of the customers 80 eventually signing up for electronic bill presentment. In such a case, the IIP 20 is able to immediately present an electronic bill to the previous paper customer 80. Element 245 is a reformatting processor which reformats the legacy billing data from the biller 5 in the appropriate format for inclusion on the database server 202. The billing data for the electronic bills is passed from the splitter 255 to the reformatting processor 245 ... The details of the formatting by reformatting processor 245 varies from biller to biller and is driven by the format of the billing data provided by the biller. The reformatting processor 245 feeds the Summary data file 210 and

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the E-Bill database 215 with the data as described above with respect to each of these databases 210, 215. ", and

*Col.13, lines 27-62, "With respect to the Summary 210 and E-Bill 215 data files, BAP system 200 is capable of performing the following functions: storing a predetermined amount (e.g., thirteen months) of bill data history for each biller 5; accepting manual entry/update of bill data and producing an audit trail; receiving, editing and uploading legacy billing data files from biller 5; sending and receiving summary data; producing audit trails of all addition, change, and delete activity on files 210 and 215; extracting, reformatting, and transmitting billing data files; performing custom analysis of bill data and producing reports; and providing expandability for anticipated growth of bill and non-bill data (e.g., marketing inserts 60). With respect to the marketing inserts 60 contained in file 235, the BAP 200 can: receive and store a predetermined amount (e.g., thirteen months) of insert history; receive, store and execute the logic required for developing and executing the conditional targeting associated with the marketing inserts 60; track a wide variety of access statistics (e.g., number read by customers 80, number responded to, types of customers 80 who responded . . .); online processing of responses from customers 80 (e.g., "I want to buy that luggage, please debit my account and send it to . . . "); and certification that an insert was read (for regulatory purposes among others). ... Armed with all of the above, the BAP 200 is capable of creating an electronic bill. How the electronic bill is formulated (in an email, as an HTML page . . .) and where it is delivered (to an email address, to a presentment site . . .) will be governed by the customers' 80 enrollment data contained in database 205. **Application `plug-ins` residing on application server 240 accomplish the actual formatting of the electronic bills. The plug-ins contain the software required to format the data in E-Bill 215 and Summary 210 files for the channel of distribution to which an electronic bill is to be published. There is a different plug-in for each channel of distribution."***

Note: The above segments disclose that the sets of data used for bill contents are stored as a plurality of software objects, that is a subset of objects, in an object oriented E-bill file

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215. This indicates that the subset of objects required for to provide bill contents for a particular bill recipient are instantiated, i.e. created or generated whenever invoked and in order to generate a plurality of data, such as *presentment configuration data (e.g., Email address, Email system/protocol, browser type and version . . .); bill format preferences (e.g., send me summary only, partial details, full details . . .); reminder preferences* The structure and content of the *Summary file 210 and the E-Bill file 215 varies from biller to biller*", will require repetitive invoking of the plurality of software objects. The object-oriented E-Bill file 215 receives the data from several databases/servers and billers.

Regarding claim 25, Ensel discloses that the method of claim 1, wherein a portion of the collected data is correlated to more than one of the specific fields in the bill format (see at least col.10, line 21-col.11, line 5, which describes an E-bill file 215 varying from biller to biller and includes fields such as, customer's name, account number, address, etc. and this information is collected by the IIP to present the bills to the customers. The information collected on customer's name, address, account number, biller's information, account balance, etc. is the collected data which is correlated to more than specific fields in the bill format. See also col.10, line 21-col.14, line 53).

Regarding claims 26-27, Ensel, does show that the collected data further comprises detailed information pertinent to a billing account of the client and segmenting the detailed information into different portions of the bill (see at least col.10, line 21-col.14, line 53. The details of the charges on a credit card plus marketing inserts correspond to the claimed detailed information pertinent to a billing account which is segmented into different portions of the bills as details about charges and marketing/advertising information).

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Regarding claim 28, Ensel discloses that the method of claim 24, further comprising the steps of generating separate images from the collected data and correlating the separate images to at least two specific fields (see at least col.10, line 21-col.14, line 53 which discloses generating bills for different bills to customers. For different billers for the same customer two different bills/ bill images would be generated form the collected data and the two different bills would correlate to at least two specific fields such as biller's name, customer's account number, customer's name, account balance, etc.).

Regarding claim 29, Ensel discloses that the method of claim 28, wherein the separate images further comprises summary information and detailed information. (see at least col.10, lines 50, "*The structure and content of the **Summary file 210** and the **E-Bill file 215** varies from biller to biller. The Summary file includes the highest level representation of the customer's bill. Examples of the type of data included in the Summary file 210 are the customer's name, account number, location..... The E-Bill data residing in this file 215 contains the **detailed description** of the customer's bill (e.g., details of all of the charges on a credit card for the applicable period in the case of a credit card biller).*". The information in summary file 210 and file 215 corresponds to the claimed summary information and detailed information which are included in the bill to be presented to the customer, see col.13, line 52-col.14, line 8).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6.1 Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ensel and further in view of Lakritz (US Publication 2003/0140316).

Regarding claim 32, please note that it has been rejected under first paragraph of 35 U.S.C. 112 as being not enabled. Ensel teaches particularized billing services as analyzed and discussed in claim 1 above. Ensel does not disclose the steps of selecting a language in which to produce the bill and converting all correlated data to the selected language prior to generating the bill. However, Lakritz discloses this limitation of selecting a language in which to produce a document [document includes a bill] and convert all correlated data to the selected language prior to generating the document for the intended recipient (see at least the "Abstract", Figs 2,3,5,7,10,.12, and paragraphs 0001, 0011-0014, 0028-0029, 0109 and 0125). In view of Lakritz, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Ensel to incorporate the feature of selecting a language in which to produce the document or a bill and converting all correlated data to the selected language prior to generating the bill because it would help the system for allowing a conversion to be made from a source language to the native language of the consumer and would provide a convenient way to produce and provide documents including bills in the target language of the recipient of the document, as explicitly demonstrated in Lakritz.

7 *Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as*

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potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

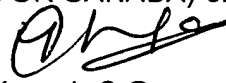
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
3/12/2007